

John L. Howes

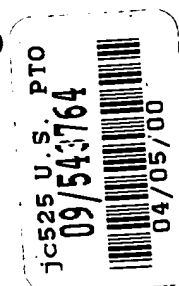
Containerized Liquid Coating Product
Direct Supply Business Method

31 March 2000

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A. MPEP 708.02 VIII. SPECIAL EXAMINING PROCEDURE FOR CERTAIN NEW APPLICATIONS - ACCELERATED EXAMINATION

1. Petitioner respectfully submits that MPEP 708.02 VIII stipulates the following requirements:

- (a) submission of "a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i)";
- (b) presentation of "all claims directed to single invention";
- (c) submission of a statement "that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc";
- (d) submission of "one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record;"
- (e) submission of "a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references."

2. Petitioner respectfully submits that requirement (a) above is fulfilled by the present document and the cheque in the amount of \$130 attached hereto

3. Petitioner respectfully submits that requirement (b) above is fulfilled by the present application for patent filed herewith as all of the claims set forth in said application are properly dependent upon the single base claim which properly claims a single invention.

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4. Petitioner respectfully submits that requirement (c) above is fulfilled by the instant statement that a preexamination search was conducted and that the field of the said search was comprised of:

Class 705: Subclasses: All.

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5. Petitioner respectfully submits that a full copy of each reference deemed most closely related to the subject matter encompassed by the claims is attached hereto.

6. Petitioner respectfully submits that a detailed discussion of said references follows in B. Detailed Discussion Of The Prior Art immediately below and that said detailed discussion further points out, with the particularity required by 37 CFR 1.111(b) & (c), how the claimed subject matter is patentable over the references.

B. DETAILED DISCUSSION OF THE PRIOR ART

7. The prior art considered most pertinent to the instant invention is comprised of the web sites or home pages currently accessible on the internet advertising paint product made by different manufacturers including PPG, Sherwin-Williams, and Kelly-Moore which all offer assistance in:

- (a) base material selection;
- (b) standard color selection,
- (c) calculation of volume required as determined by the size of the surface to be covered, and
- (d) closest local retail store selection.

In accordance with these features customers can review information regarding the paint base, review color swatches, input dimensions defining the area to be covered, and input an address which will yield the closest retailer to the address inputted.

8. Petitioner respectfully submits that the presently claimed subject matter is patentably distinguished over the public disclosure comprised of the web sites discussed immediately above in paragraph 7 by the result obtained by the present invention as set forth in claim 1, the delivery of containerized liquid coating of a particular, non-standard color to a delivery address given by the consumer during placement of a customer order; that this result is necessarily unexpected in view of

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this prior art as evidenced by the assumption of the prior art web sites that a customer must purchase the paint from a local retailer where colorant can be added as necessary.

9. Petitioner respectfully submits that with regard to use of digital processing in control of mixing colorant with base to achieve a given color U.S. Patent #4,887,217 issued 12 December 1989 to The Sherwin-Williams Company is considered exemplary of the known prior art. The process disclosed therein utilizes an index for the difference in color between wet and dry conditions which is considered a well known and fundamental impediment to achieving duplication of a particular shade desired. The wet paint may look right to the customer but when dry the shade changes and the result is frequently unsatisfactory. The process disclosed determines correction factors from readings by a spectrophotometer or colorimeter of the wet paint during manufacture using an index for correlating the wet and dry states with regard to color, tone, and shade.

10. Petitioner respectfully submits that the process disclosed in U.S. Patent #4,887,217, in being "for the manufacture of paint to match the color of a standard paint within a specified color tolerance" (Claim 1) assumes addition of colorant by a local retailer in order to achieve a particular, non-standard, color and that the presently claimed invention as set forth in claim 1 achieves a result which is unexpected in view of the prior art in providing delivery of containerized liquid coating of a particular, non-standard color to the address given by a consumer during order placement.

11. Petitioner respectfully submits that U.S. Patent #5,268,849 for 'Process and Apparatus For Dispensing Liquid Colorants Into A Paint Can, And Quality Control Therefor' cites U.S. Patent #4,887,217 and concerns the manufacture of paint, not the addition of colorants by a retailer. This patent discloses an "automated paint-batching system" with at least one dispensing station including a scale which measures the weight of the paint can and contents therein during dispensing of either

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colorant or base. Each paint can further has a "bar-code label" "attached to it" (Abstract) which is correlated to an address in computer memory "which stores the color-formula for that can and other information" which is understood to refer to the formula used in making the paint held by the can so identified. Computer processing is further utilized in tracking the paint can through "paint-batching cells of the system" wherein bar codes are read "at a plurality of stations along the entire manufacturing process."

12. Petitioner respectfully submits that in addition to the use of a bar code and computer memory for tracking paint cans and the paint therein during manufacture, U.S. Patent #5,268,849 further claims a "method of automating the production of paint in paint cans", including the step of "placing an order for a paint can of specified size and paint-color at a remote location" in which it is presumed that the order actually pertains to a specified volume and color of paint held in a paint can (claim 19). Other steps involve "emplacing the bar-code on the empty paint transported" wherein it is assumed that the word 'can' was inadvertently omitted in between "paint" and "transported" and "conveying the empty paint can from said bar-code reader-station to one of a plurality of paint-batching cells" which step is "controlled by said operations-control computer, and comprising choosing said one cell of the plurality of cells to which that empty paint (can) is to be conveyed."

13. Petitioner respectfully submits that the presently claimed invention is patentably distinguished over the prior art discussed immediately above in paragraphs 11 & 12 by the result obtained by the present invention as set forth in claim 1, the delivery of containerized liquid coating of a particular, non-standard color to a delivery address given by the consumer during placement of a customer order; that this result is necessarily unexpected in view of this prior art as evidenced by the fact that the process is applicable only to manufacture of standard color paint and the requirement that a customer must purchase the paint from a local retailer where colorant can be added as necessary.

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14. Petitioner respectfully submits that U.S. Patent #5,083,591 is a divisional result of the application resulting in the patent discussed immediately above in paragraphs 11 - 13 above which differs from its sibling patent in possessing the following as a base claim:

A method for formulating paint by dispensing paint ingredients into a paint can, in an apparatus comprising a first tint-dispensing station storing various liquid colorants for dispensing thereat, and a second base-dispensing station storing liquid base for dispensing thereat, said method comprising:

- (a) conveying a paint can to a first tint-dispensing station;
- (b) dispensing a prewetting amount of liquid base at the first tint-dispensing station;
- (c) after said (b) step, dispensing liquid colorants, one at a time, at said first tint-dispensing station making up the formula of the color of the pint for the paint can;
- (d) after said step (c), conveying the partially-filled paint can to a second base-dispensing station;
- (e) dispensing the remaining volume of liquid base of the particular formula for the respective paint can at the second base-dispensing station;
- (f) thereafter, conveying the paint can from the second base-dispensing station.

15. Petitioner respectfully submits that the presently claimed invention is patentably distinguished over the prior art discussed immediately above in paragraph 14 by the result obtained by the present invention as set forth in claim 1, the delivery of containerized liquid coating of a particular, non-standard color to a delivery address given by the consumer during placement of a customer order; that this result is necessarily unexpected in view of this prior art as evidenced by the fact that the process is applicable only to manufacture of standard color paint and the requirement that a customer must purchase the paint from a local retailer where colorant can be added as necessary.

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16. Petitioner respectfully submits that U.S. Patent 4,967,938 for 'Paint Dispensing Apparatus' discloses a system similar to that discussed above in paragraphs 11 - 14 which "comprises a plurality of container assemblies mounted for indexing" by a "dispensing station" which includes apparatus for actuating meters and valves in the assemblies thereby controlling the automatic dispensing of "metered colorants into passing containers (holding) paint base material, according to formulae stored in the apparatus." (Abstract) and that U.S. Patent #5,153,825 for 'Paint Formula Retrieval And Management System And Method' "presents a ruled scale representation of actual sizes on a display, including a bar portion" moved to select "the desired paint size" which further possesses the capability of storing "multiple variants of a formula" and reporting "the previous day's paint usage" (Abstract).

17. Petitioner respectfully submits that the presently claimed invention is patentably distinguished over the prior art discussed immediately above in paragraph 16 by the result obtained by the present invention as set forth in claim 1, the delivery of containerized liquid coating of a particular, non-standard color to a delivery address given by the consumer during placement of a customer order; that this result is necessarily unexpected in view of this prior art as evidenced by the fact that the process is applicable only to manufacture of standard color paint and the requirement that a customer must purchase the paint from a local retailer where colorant can be added as necessary.

18. Petitioner respectfully submits that the Pantone™ system is considered exemplary of other commercially available systems which identify a large number of colors by a number or code which is correlated to a colorant formula used in mixing of colorant with a standard color liquid coating to achieve a paint of a particular color, tone and that regardless of the system utilized in manufacture of standard color liquid coatings, subsequent colorant dispensement of metered amounts into a container of standard color liquid coating by the local retailer is required in order to achieve a particular color selected by a customer.

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19. Petitioner respectfully submits that the presently claimed subject matter is distinguished over the prior art discussed above inclusive of the Pantone™ system by the result obtained by the present invention as set forth in claim 1, the delivery of containerized liquid coating of a particular, non-standard color to a delivery address given by the consumer during placement of a customer order; that this result is necessarily unexpected in view of the prior art wherein standard color paint by the manufacturer is stocked by local retailers and a customer must purchase the paint from a local retailer where colorant can be added as necessary.

20. Petitioner respectfully submits that, with regard to bridging the gap between customer and manufacturer with computer processing and the electronic transfer of information, attention to terminology and the applicable context is also quite relevant in comparison of the presently claimed subject matter and the pertinent prior art. For example U.S. Patent #5,463,555 for a 'System and Method For Integrating A Business Environment With A Process Control Environment' claims:

A computer-based system for integrating a computerized business system with a computerized manufacturing process, wherein the computerized business system creates a work order containing data specifying a product to be manufactured by the computerized manufacturing system, comprising:

a business systems interface configured to receive the work order from the computerized business system and to extract the data from the received work order;
and

an event response processor coupled to said business system interface and configured to apply at least one rule to said extracted data to generate one or more setpoints, and to provide said one or more setpoints to the computerized manufacturing system, wherein said one or more setpoints are manufacturing process settings used to manufacture the product. (Claim 1)

wherein it must be recognized that when the "computerized business system creates a work order"

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this event must be triggered by another action which, at some point, must be a human action or else the entire system is autonomous and is of no relation and no use to the world of human beings.

21. Petitioner respectfully submits that the essential point requiring recognition with regard to the prior art discussed above in paragraph 20 in comparison with the presently claimed subject matter is not the fact that the 'work order' must be the result of a previous human action but, as evidenced by this observation, that the system disclosed therein is unconcerned with anything proceeding the computer generation of the work order which is therefore not to be confused with a customer order of the presently claimed invention including a delivery address and the delivery of containerized color liquid coating to said delivery address which is wholly beyond the confines of the system disclosed in this prior art and which hence distinguishes the presently claimed subject matter over the same.

22. Petitioner respectfully submits that customer orders for products unassociated with liquid coatings may be placed with various entities by accessing and utilizing an appropriate web site on the internet; that Dell Computer is an example of such whereby computers are essentially manufactured to order with features specified by a customer from a menu with a plurality of options for each feature. A total price is readily generated by the software after sufficient specification by the on-line customer and an order with Dell readily placed. Payment is made by credit card and the computer, or computer system including peripherals such as a monitor, printer, et cetera, is shipped to the address provided by the customer.

23. Petitioner respectfully submits that all prior art known facilitating ordering and delivery of product to an address specified by the customer as exemplified by the reference discussed above in paragraph 22 is exclusive of the supply of containerized liquid coatings of a particular, non-standard, color which aspect patentably distinguishes the presently claimed subject matter over said prior art.

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C. REQUEST FOR BOTH EXPEDITION AND ALLOWANCE

24. Petitioner respectfully submits that while various systems, as described above, are known which enable:

- (a) specification and ordering of non-paint product such as computers;
- (b) computer automated manufacture of standard paints;
- (c) addition of colorant by a retailer to a standard paint in accordance with a formula correlated to a number or code identifying a particular non-standard paint color;
- (d) selection of a particular non-standard paint color on an internet web site;

the consumer of a liquid coating requiring addition of colorant to a standard paint in order to achieve a particular, non-standard, paint color still must visit a local paint retailer in order to obtain this paint which includes ordering the paint, waiting for the addition of colorant and for mixing the paint, and transport of the paint from the retailer. It is further noted that liquid coating product generally is available only in standard volumes and that there are economic and technical reasons encouraging the purchase of a single standard volume of paint exceeding the amount required and that therefore the presently claimed subject matter as defined by present claim 1 is patentably distinguished over the known prior art by the result, unexpected by said prior art, of:

- (a) a customer being able to avoid a visit to a retailer in order to obtain liquid coating product, particularly paint of a particular, non-standard, color, and thereby avoid the time lost in this endeavor;
- (b) economically providing liquid coating product in quantities unrestricted by the use of standard volume containers;
- (c) ensuring provision of a particular, non-standard, color which is more precise than conventional practice thereby ensuring that independent orders of that color result in paint of a color which is not appreciable different from each other.

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25. Petitioner respectfully submits that for all of the reasons given above the presently claimed subject matter has been demonstrated to be patentably distinguished over the known prior art which has been discussed above and that all other requirements stipulated by MPEP 708.02 VIII have been met and further that the present application for patent attached hereto is in full and proper condition for allowance which action Petitioner humbly requests in addition to expedition of said application.

Respectfully yours,

Peter Gibson, Reg. #34,605

Peter Gibson, Atty./Agent of Record, Reg. #34,605

Telephone: 410/358-5912; Facsimile: 410/358-9636